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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,426	11/15/2004	Udo Wirthwein	4070-72PUS	4334
27799	7590	07/06/2006	EXAMINER	
COHEN, PONTANI, LIEBERMAN & PAVANE 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176			LE, MARK T	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/510,426		WIRTHWEIN ET AL.	
	Examiner		Art Unit	
	Mark T. Le		3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. In the specification, page 5, it is noted that EP 150 264 A1 is described as "a body produced in this way in the manner known from EP 150 264 A1"; wherein, it appears that the expression "a body produced in this way" refers to the manner of how the damping body of the present invention is made as described in the preceding paragraph on page 5. Applicant is required to clarify this comparison between EP 150 264 A1 and the structure of the present invention so that appropriate actions may be taken.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over German reference DE 199 19 664 A1.

The German reference discloses a molded body material for damping mechanical vibrations, similar to that recited in the instant claims, including a base material made of plastic and a vibration damping filling made of metal particles, which can be in the form of dust, grains or chips with a volume ratio between 1 and 95%, and which can be made of pure metal, alloys, ceramic metal or a mixture of those.

Regarding the instant claimed intended use in a railway application as recited in instant claim 7, note that since the body material described in the German reference is inherently capable of the instant claimed use, the intended use limitation of the claim is considered met.

Regarding the instant claimed density of greater than 2.4 g/cm³ or 2.5-3.9 g/cm³ or 2.9-3.5 g/cm³, note that densities of known plastics materials (e.g. a thermal plastic material being about less than 1 g/cm³) are generally lower than the instant claimed density, and the densities of known metal materials (e.g. iron being about 8 g/cm³) are generally higher than the instant claimed density (Official Notice is taken). Therefore, it would have been obvious to one skilled in the art to form the mixture of plastic and metal for the structure of the German reference at a certain metal ratio between 1 and 95%, as suggested in the German reference, and thereby produces a damping body having a density within the ranges as claimed.

Regarding the instant claimed base material being polyethylene or polypropylene, and the instant claimed vibration damping filler material being hematite

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or magnetite or roll scale, note that since polyethylene and polypropylene are plastics, and hematite, magnetite and roll scale are metals, such plastics and metals are considered to be within the scope of the teaching of the German reference. Therefore, it would have been obvious to one skilled in the art to construct the damping body of the German reference by selecting a known type of plastic materials, which may include polyethylene or polypropylene, and a known type of metal materials, which may include hematite or magnetite or roll scale, because such plastic materials and metal materials are considered to be within the context of the teaching of the German reference.

Regarding the instant claimed metal constituting 35-70% of the body material, as recited in instant claim 11, note that such claimed range is within the range of 1-95% as suggested in the German reference.

4. Claims 13-19 are allowable.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should further consider the structures of Japanese reference JP 7145270.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Le whose telephone number is 571-272-6682. The examiner can normally be reached on Mon-Fri (2:00-8:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Mark T. Le
Primary Examiner
Art Unit 3617

mle
6/21/06